

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Patent Application of)
Yutaka Nakatsu ET AL.)
Serial No. 08/610,758)
Filed: March 5, 1996)
For: Apparatus Having Means For)
Printing Video Signals of)
Video Camera Attached)
Thereto)

Examiner: A. Moe

Art Unit: 2712

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APPEAL BRIEF

Assistant Commissioner of Patents
BOX AF
Washington, DC 20231

Sir:

This is an Appeal Brief under Rule 192, appealing the final decision of the Primary Examiner dated November 9, 1998 (Paper No. 13). Each of the topics required by Rule 192 is presented herewith and labeled appropriately.

I. Real Party in Interest

Sony Corporation of Tokyo, Japan ("Sony") is the real party in interest of the present application. The inventors of record executed an assignment of all rights in the present application to Sony, said assignment recorded by the U.S. Patent and Trademark Office at **reel 7914, frame 0720**.

II. Related Appeals and Interferences

There are no appeals or interferences related to the present application of which the Appellant is aware.

III. Status of Claims

Claims 1-7, set forth in the Appendix, stand finally rejected under 35 U.S.C. § 103(a). No other claims are present in this application. Accordingly, Appellant hereby appeals the final rejection of claims 1-7.

IV. Status of Amendments

The Patent Office ("USPTO") mailed the first Office Action on the merits on October 7, 1997, wherein the Examiner rejected all pending claims 1-6 under 35 U.S.C. 102(b) in view of U.S. Patent No. 4,937,676 issued to Finelli et al. (hereinafter "Finelli"). The Examiner rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Finelli in view of U.S. Patent No. 5,561,462 issued to Nagano et al. (hereinafter "Nagano"). Applicant presumes this rejection applies to claim 2, as claim 3 does not define an LCD device.

Appellant responded by pointing out the differences between the Finelli invention and that defined by pending claims 1-6. Appellant made no substantive amendments to the claims.

The USPTO mailed the second Office Action, made final, on March 16, 1998. In this Action, the Examiner maintained the rejection of claims 1 and 3-6 under 102(b) in view of Finelli and claim 2 under 35 U.S.C. § 103(a) over Finelli in view of Nagano. Appellant responded by amending claims 1, 4, and 5, and adding a new claim 7. The Examiner notified Appellant by an Advisory Action that the proposed amendments would not be entered. In response, Appellant filed a Continued Prosecution Application ("CPA") on July 9, 1998.

The USPTO mailed the first Office Action on the merits on August 6, 1998. In this Action, the Examiner rejected claims 4 and 5 under 35 U.S.C. § 112, second paragraph, claims 1-7 under 35 U.S.C. § 103(a) over Finelli in view of U.S. Patent No. 5,621,492 issued to Beveridge et al. (hereinafter "Beveridge"), and claim 4 as being unpatentable under 35 U.S.C. § 103(a) over Finelli in view of Beveridge and further in view of U.S. Patent No. 4,935,763 issued to Itoh et al. on June 19, 1990 (hereinafter "Itoh"). Appellant responded by amending claims 4 and 5 and submitting arguments traversing the rejection under § 103(a).

On November 9, 1998, the USPTO mailed an Office Action finally rejecting claims 1-7. In this Office Action, the

Examiner entered the amendments to claims 4 and 5 but found the arguments traversing the § 103(a) rejection unpersuasive.

Appellant has filed no other amendments to the present application.

V. Summary of the Invention

The present invention relates to a video printer having a video camera detachably attached to the printer. The video camera is electrically coupled to the video printer, and a user can operate the video camera and the video printer by use of operation systems 8, 9 disposed on the front upper surface of the video printer housing. (Spec., p. 2, lines 19-23; p. 5, lines 1-2; p. 6, lines 17-20).

The video camera 6 operation system 8 includes a shuttle ring 10 for fast-forwarding or rewinding a video picture displayed on the picture screen of a liquid-crystal display monitor 7. (Spec., p. 6, lines 21-27; p. 7, lines 1-4).

The video printer 1 operation system 9 includes a memory button 14 for storing a video picture of the video

camera 6 in the memory of the video printer 1, a memory picture button 15 for accessing the video picture stored in the memory of the video printer 1, an input picture button 16 for entering video data indicative of the video picture into the memory of the video printer 1 and a print button 17 for energizing the video printer 1. (Spec., p. 7, lines 5-16).

To print out a video picture, the user, using the operation system 8, selects the video picture to be printed. The user prints out the selected image by operating the video printer 1 using the operation system 9. (Spec., p. 8, lines 14-19). Both operation systems 8, 9 are conveniently located on the printer housing.

VI. Issues

In the Office Action, made final, of November 9, 1998, the Examiner rejected all pending claims, the claims on appeal, under 35 U.S.C. § 103(a). The Examiner rejected claims 1, 3 and 5-7 as being unpatentable over Finelli in view of Beveridge. The Examiner rejected claim 2 as being unpatentable over Finelli in view of Beveridge and further in view of Nagano. The Examiner rejected claim 4 as being unpatentable over Finelli in view of Beveridge and further in view of Itoh.

Consequently, the issues presented on appeal are (1) whether claims 1, 3 and 5-7 are properly rejected as being unpatentable under 35 U.S.C. § 103(a) over Finelli in view of Beveridge; (2) whether claim 2 is unpatentable under 35 U.S.C. § 103(a) over the combination of Finelli, Beveridge and Nagano; and (3) whether claim 4 is unpatentable under 35 U.S.C. § 103(a) over the combination of Finelli, Beveridge and Itoh.

VII. Grouping of Claims

For purposes of the issues presented by this appeal, claims 1-7 stand or fall together as a group.

VIII. Arguments

I. The Examiner has failed to establish a *prima facie* case of obviousness. The cited references are directed to "still picture photography", not printing images selected from a plurality of images recorded as continuous motion images.

Claim 1, the sole independent claim, stands rejected under 35 U.S.C. § 103(a) over Finelli in view of Beveridge.

Claim 1 recites:

A video printer for printing on a printing paper as a hard copy a video picture selected from a plurality of video pictures recorded by a video camera as continuous motion images, said printer comprising:

a video printer housing portion with a video camera attached thereto;

a signal input and output connection terminal disposed on said video printer

housing portion for electrically connecting said video camera attached to said video printer housing portion to said video printer; and

an operation system disposed on said video printer housing portion for operating said video camera.

(emphasis added).

The Examiner relies on Finelli as the primary reference. The Examiner interprets Finelli as teaching a "video printer for printing on a printing paper as a hard copy, and the printer comprising: printer housing to which a video camera can be attached." (Paper No. 13, p. 4) (internal cites omitted). Finelli discloses the use of a still picture camera that may be connected to a video printer. As the Examiner admits, "Finelli ... does not explicitly show [] continuous motion images captured by the video camera." (Paper No. 13, p. 4). In fact, there is no teaching or suggestion in Finelli of printing an image selected from a plurality of images recorded as continuous motion images.

However, the Examiner cites Beveridge as teaching "the use of [a] video camera [for capturing] continuous motion images." *Id.* The Examiner also cites Beveridge for the proposition that a user can select a single image from the "continuous sequence of images" for printing. *Id.*

Contrary to the Examiner's beliefs, Beveridge, like Finelli, explicitly teaches printing an image captured as a "still image." Beveridge teaches that [a] continuous

sequence of images represented by the image bearing light are ... displayed on a video monitor allowing the user to see an electronic representation of himself. The user can adjust his appearance and pose while viewing the results on the video monitor.

The image acquisition means is user controlled to allow the user to choose a single image from the continuous sequence of images. In this way, the user can signal to the image acquisition means that a desired pose has been struck. The image acquisition means then flashes a strobe and grabs a subsequent frozen image.

(col. 2, lines 17-33) (emphasis added).

Although Beveridge discloses the use of a video camera to record images, Beveridge teaches that a "still picture" is taken of the image to be printed. Beveridge teaches that when the user is ready, the user signals the image acquisition means, which "flashes a strobe and grabs a subsequent frozen image." (col. 2, line 31-32) (emphasis added). In other words, once the user has achieved a desirable pose, the pose is held in anticipation of the "picture taking moment[,]" which can range from instantaneously up to three seconds. (col. 4, lines 36-41). If the user accepts the captured "still" picture image, the image is sent to the video printer for printing.

(See col. 4, lines 50-60). From the foregoing, it is clear that the image printed is not recorded as a continuous motion image. Rather, the video camera captures the image as a "still" image in a manner virtually identical to that taught or suggested by Finelli.

At column 4, Beveridge explains how the "still image" is captured:

... the user then poses, adjusts himself or herself appropriately, and when ready indicates so by pressing a freeze button 67 on the user interface 18. A countdown display is then indicated on the monitor showing the user 8 when the exact picture taking moment will be. This can range from instantaneously up to three seconds. During this time, the charge on the strobe capacitor is checked and an iris control on the video camera 18 is changed from a large aperture utilized when modeling to a fixed small aperture thereby increasing depth of field.

The strobe 20 is then fired to correct the exposure by eliminating fluctuations in ambient light intensity and color temperature.

At the end of the countdown, the strobe 20 fires and the video camera 14 captures the image which is frozen by the frame grabber 22 and is displayed on the video monitor 16. User controls on the user interface 18 are illuminated to allow the user 8 to accept the frozen image being displayed by pressing PRINT 66 or to redo the frozen image by pressing RETAKE 64. Pressing RETAKE 64 causes the image acquisition system 10 to repeat the above process.

(col. 4, lines 8-57) (emphasis added).

The above excerpts unambiguously teach that "still image photography" is used to capture the images printed by the video printer. If the captured image is unsatisfactory, the user does not "rewind" the tape and select another image from recorded images. Instead, the user presses the "RETAKE" button to restart the photographing session. See Beveridge, Figure 3 (a flowchart explaining the picture taking process).

In combination, Finelli and Beveridge do not teach or suggest printing a video picture selected from a plurality of video pictures recorded by a video camera as continuous motion images. Instead, the combination teaches and suggests printing an image taken as a "still" or "frozen" image.

Given the foregoing, the Examiner has not established *prima facie* obviousness. "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." See *In re Bell*, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 189 USPQ 143, 147 (CCPA 1976)). Appellant's invention is directed to a video printer for printing as a hard copy an image selected from a plurality of images recorded as continuous motion images. The cited

references do not teach printing images selected from images recorded as continuous motion images.

Moreover, the only document of record that teaches printing a video picture selected from a plurality of video pictures recorded by a video camera as continuous motion images is Appellant's specification. It is well settled that Appellant's specification can not be used as a guide for selecting and combining prior art references. See *Grain Processing Corp. v. American Maize-Products Co.*, 5 USPQ2d 1788, 1972 (Fed. Cir. 1988). Thus, the combination of Finelli and Beveridge is not proper. And even if the combination is deemed proper, Finelli in combination with Beveridge does not teach the claimed invention. Therefore, Appellant respectfully requests withdrawal of the rejection of claims 1-7 under 35 U.S.C. 103(a).

II. Combining Finelli and Beveridge impermissibly requires substantial reconstruction and redesign of the elements disclosed by both references to achieve the claimed invention.

The combination of Finelli and Beveridge requires substantial reconstruction and redesign of the elements disclosed by both references. Each reference teaches the use of a "strobe" for taking a still picture image. Both teach that the still picture image is electrically transmitted to the video printer for printing.

In modifying Finelli and Beveridge, the strobe disclosed by both references for capturing the still picture image would have to be replaced by a means for selecting an image from a plurality of images recorded as continuous motion images. The Finelli and Beveridge systems would also require modification to include a means for isolating the selected image from adjacent images and a means for storing the selected image in a memory device. Neither Finelli nor Beveridge teaches or suggests how the necessary modifications would be made.

Not only are the needed modifications substantial, the modifications would change the principal of operation of the Finelli and Beveridge devices. Instead of using a strobe to capture a single image (Beveridge, col. 3, lines 53-60), the selected image would have to be selected from a plurality of continuous motion images, stored in a memory device, and transmitted a printer. It is well settled that references are not combinable if the combination must be modified in a manner that alters the principle of operation of the combined references to achieve the claimed invention. See *In re Ratti*, 123 USPQ 349, 352 (CCPA 1959). Here, principle of operation altering modifications are required. Therefore, claims 1-7 are not properly rejected

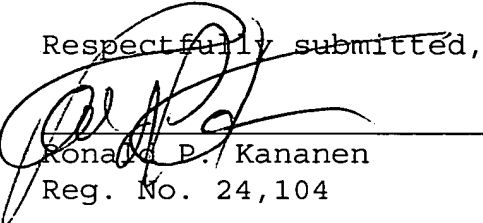
under 35 U.S.C. § 103(a) over the combination of Finelli and Beveridge.

IX. Conclusion

Appellant believes that the claims, as presented on appeal, are patentable over the art cited in support of the rejection under 35 U.S.C. § 103(a). Accordingly, Appellant respectfully requests reversal of the rejection of claims 1-7.

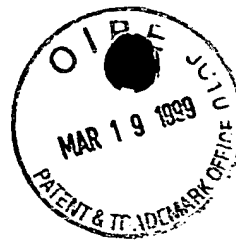
Dated: March 19, 1998

Respectfully submitted,



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APPENDIXCLAIMS ON APPEAL

1. A video printer for printing on a printing paper as a hard copy a video picture selected from a plurality of video pictures recorded by a video camera as continuous motion images, said printer comprising:

a video printer housing portion with a video camera attached thereto;

a signal input and output connection terminal disposed on said video printer housing portion for electrically connecting said video camera attached to said video printer housing portion to said video printer; and

an operation system disposed on said video printer housing portion for operating said video camera.

2. A video printer according to claim 1, wherein said video camera is of a video camera with a liquid-crystal display monitor, and said video printer is operated while a video picture, a video picture entered into the video printer or the manner in which the video printer is operated is visually confirmed on a picture screen of said liquid-crystal display monitor.

3. A video printer according to claim 1, wherein said video printer housing portion has a pair of guide rails formed at its portion to which said video camera is attached, and said guide rails guide an electrode terminal disposed on a bottom surface of said video camera to the position at which said electrode terminal comes in contact with said input and output connection terminal.

4. A video printer according to claim 1, wherein said video camera operation system includes a shuttle ring for displaying on the picture screen of said liquid-crystal display in a play mode, pause mode, fast-forward mode or rewind mode a video picture recorded as continuous motion images.

5. A video printer according to claim 1, wherein said video camera operation system includes a memory operation means for storing video data indicative of a video picture selected from said plurality of video pictures recorded as continuous motion images by said video camera in a memory of said video printer.

6. A video printer according to claim 1, wherein said video camera operation system includes input operation means for entering video data indicative of video picture in a memory of said video printer.

7. A video printer according to claim 1, wherein said printer supports a video camera operation switch and a printer operation switch.

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